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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,483

11/21/2003

Taylor James

AOL0149

2527

22862

7590

03/22/2006

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EXAMINER

ORTIZ, BELIX M

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,483

Applicant(s)

JAMES ET AL.

Examiner

Belix M. Ortiz

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/21/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: in figure 3, characters “31” and “34” are not described on the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as “Annotated Sheets” and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 15, the phrase “may be” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 2-14 and 16-28 are rejected under 35 U.S.C. 112, second paragraph, as being dependent from rejected independent claims 1 and 15.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-5, 10-11, 14-19, 24-25, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Edlund et al. (U.S. patent 6,546,388).

As to claim 1, Edlund et al. teaches a search method, comprising the steps of:

- a user posing a query to a search engine (see abstract; figure 1, character 156; column 1, lines 62-67; column 2, lines 1-4; and column 3, lines 54-55);
- a first list of search results being returned to the user by the search engine in response to the query, the search results each associated with one or more Web sites (see abstract; figure 3, character 303; column 3, lines 41-43; and column 3 lines 55-58);
- providing a selection mechanism within the first list that allows the user to identify search results of interest from among those search results within the first list (see column 3, lines 52-36);
- the user applying a gesture to the selection mechanism to identify search

results of interest from among those search results within the first list (see column 3, lines 60-66);

providing a second list of search results to which the search results of interest may be added (see column 3, lines 66-67 and column 4, lines 1-5);

adding the search results of interest to the second list in response to the user gesture (see column 3, lines 66-67 and column 4, lines 1-5); and

allowing a user to visit Web sites associated the search results of interest from the second list without having to select and return to the first list of search results (see column 6, lines 44-46; column 7, lines 2-4; and column 7, lines 17-23).

As to claims 2 and 16, Edlund et al. teaches wherein the search method is implemented in a user client (see figure 1, character 154).

As to claims 3 and 17, Edlund et al. teaches wherein the user client is a browser (see column 1, lines 26-40 and column 9, lines 8-15).

As to claims 4 and 18, Edlund et al. teaches wherein the method is implemented in a server (see column 7, lines 21-26).

As to claims 5 and 19, Edlund et al. teaches wherein the user gesture is a mouse-over click gesture (see column 1, lines 30-32; column 3, lines 66-67; and column 4, lines 1-5).

As to claims 10 and 24, Edlund et al. teaches wherein the search comprises any of a content search, file search, and a database search (see figure 1, character 158 and column 3, lines 44-45).

As to claims 11 and 25, Edlund et al. teaches the method further comprising the step of:  
saving entries in the second list in chronological order, where most recent sites are displayed at a top of the second list (see column 6, lines 64-67).

As to claims 14 and 28, Edlund et al. teaches wherein the search method is implemented in a search portal (see column 2, lines 10-15).

As to claim 15, Edlund et al. teaches a search apparatus, comprising:  
a search engine to which a user posits a query (see abstract; figure 1, character 156; column 1, lines 62-67; column 2, lines 1-4; and column 3, lines 54-55);  
the search engine returning a first list of search results to the user in response to the query, the search results each associated with one or more Web sites (see abstract; figure 3, character 303; column 3, lines 41-43; and column 3 lines 55-58);  
a selection mechanism within the first list that allows the user to identify search results of interest from among those search results within the first list (see column 3, lines 52-36);

mean for the user applying a gesture to the selection mechanism to identify search results of interest from among those search results within the first list (see column 3, lines 60-66);

a second list of search results to which the search results of interest may be added (see column 3, lines 66-67 and column 4, lines 1-5), wherein the search results of interest are added to the second list in response to the user gesture (see column 3, lines 66-67 and column 4, lines 1-5); and

mean for allowing a user to visit Web sites associated the search results of interest from the second list without having to select and return to the first list of search results (see column 6, lines 44-46; column 7, lines 2-4; and column 7, lines 17-23).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund et al. (U.S. patent 6,546,388) in view of Lehmeier et al. (U.S. pub. 2003/0133076).

As to claims 6 and 20, Edlund et al. does not teach wherein the second list is any of a pull down and a side bar.

Lehmeier et al. teaches system and method for modifying image-processing software in response to visual test results (see abstract), in which he teaches wherein the second list is any of a pull down and a side bar (see paragraphs 45, 47, and 60).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Edlund et al. by the teaching of Lehmeier et al., because wherein the second list is any of a pull down and a side bar, would enable the method because “Upon individually selecting each of the pull-down menu arrows, the operator will be presented with a menu listing all available selections related to the associated application, image mode, image size, and image resolution, respectively. As is also shown in FIG. 4, the brightness and contrast controls 441, 443 may be similarly presented in the form of a slide bar with each respective slide bar control outfitted with corresponding left and right arrows to adjustably control either the brightness or the contrast value that is applied to the selected image data”, (see Lehmeier et al., paragraph 60).

8. Claims 7-9, 12, 21-23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund et al. (U.S. patent 6,546,388) in view of Ehrlich et al. (U.S. pub. 2002/0156685).

As to claims 7 and 21, Edlund et al. does not teach wherein the selection mechanism comprises a separate checkbox associated with each of the search results in the first list.

Ehrlich et al. teaches system and method for automating electronic commerce transactions using a virtual shopping cart (see abstract), in which he teaches wherein the selection mechanism comprises a separate checkbox associated with each of the search results in the first list (see paragraph 73).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Edlund et al. by the teaching of Ehrlich et al. because wherein the selection mechanism comprises a separate checkbox associated with each of the search results in the first list, would enable the method because "At step 345, the shopper 80 is now able to select an item from the results presented by the web application server 85 and "ADD" the item to the virtual shopping cart. This "ADD" request is sent to the shopping cart manager 95 which stores the necessary information such as the session ID, item URL, price, merchant, etc. in the shopping cart database 115", (see Ehrlich et al., paragraph 73).

As to claims 8 and 22, Edlund et al. does not teach the method further comprising the step of:

providing an edit facility for entries made to the second list.

Ehrlich et al. teaches system and method for automating electronic commerce transactions using a virtual shopping cart (see abstract), in which he teaches the method further comprising the step of:

providing an edit facility for entries made to the second list (see paragraphs 31 and 74).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Edlund et al. by the teaching of Ehrlich et al., because the method further comprising the step of:

providing an edit facility for entries made to the second list, would enable the method because “user profile manager, which maintains user account information for the virtual shopping cart web site and for various merchants' sites. This information is accessible by the user for editing purposes”, (see Ehrlich et al., paragraph 31).

As to claims 9 and 23, Edlund as modified teaches the method the edit facility providing functionality for any of editing entries, clearing all entries, and clearing individual sites (see Ehrlich et al., paragraph 74).

As to claims 12 and 26, Edlund et al. does not teach wherein the second list comprises a temporary queue in which entries are not saved across search sessions.

Ehrlich et al. teaches system and method for automating electronic commerce transactions using a virtual shopping cart (see abstract), in which he teaches wherein the second list comprises a temporary queue in which entries are not saved across search sessions (see paragraph 74).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Edlund et al. by the teaching of Ehrlich et al., because wherein the second list comprises a temporary queue in which entries are not saved across search sessions, would enable the method because “Typically, the shopping

cart exists for the duration of the shopper's session with the virtual shopping cart system 10 and is not stored long term”, (see Ehrlich et al., paragraph 74).

9. Claims 13 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund et al. (U.S. patent 6,546,388) in view of Rishe (U.S. pub. 6,339,773).

As to claims 13 and 27, Edlund et al. does not teach the method further comprising the step of:

the user designating selected entries within the second list for transfer to a bookmarks list to save information related to the selected entries for use after a current search session has ended.

Rishe teaches data extractor (see abstract), in which he teaches the method further comprising the step of:

the user designating selected entries within the second list for transfer to a bookmarks list to save information related to the selected entries for use after a current search session has ended (see column 5, lines 30-31).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Edlund et al. by the teaching of Rishe, because the method further comprising the step of:

the user designating selected entries within the second list for transfer to a bookmarks list to save information related to the selected entries for use after a current

search session has ended, would enable the method because "In addition, the user can bookmark 310 the result for future access", (see Rishe, column 5, lines 30-3).

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Belix M. Ortiz whose telephone number is 571-272-4081. The examiner can normally be reached on moday-friday 9am-5pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bmo

March 15, 2006.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**